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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Office Application of:
Kenneth Lawrence Accardi et al.

Parent Application Serial No.: 09/199,506
Parent Application Filed: November 25, 1998

Serial No.: 11/416,778

Filed: May 3, 2006

For: MEDICAL DIAGNOSTIC SYSTEM
SERVICE METHOD AND APPARATUS

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Group Art Unit: 2152

Examiner: Unassigned

Atty Docket: 15SV4769-2/YOD
GEMS:0029-1

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July 31, 2006 Date	 Helen Tinsley

APPEAL BRIEF PURSUANT TO 37 C.F.R. §§ 41.31 AND 41.37

This Appeal Brief is being filed in furtherance to the Notice of Appeal mailed on May 3, 2006, and received by the Patent Office on May 3, 2006.

The Commissioner is authorized to charge the requisite fee of \$500.00, and any additional fees which may be necessary to advance prosecution of the present application, to Account No. 50-2402, Order No. 15SV4769-2/YOD (GEMS:0029-1).

Appellants hereby request a one (1) month extension in the statutory period for submission of the Appeal Brief, from July 3, 2006 to August 3, 2006, in accordance with 37 C.F.R. § 1.136. The Commissioner is authorized to charge the requisite fee of \$120.00, and any other fee that may be required, to Deposit Account No. 50-2402, Order No. 15SV4769-2/YOD (GEMS:0029-1).

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1. **REAL PARTY IN INTEREST**

The real party in interest is General Electric Company, the Assignee of the above-referenced application by virtue of the Assignment to General Electric Company, recorded at reel 016000, frame 0028, and dated March 31, 2005. Accordingly, General Electric Company, will be directly affected by the Board's decision in the pending appeal.

2. **RELATED APPEALS AND INTERFERENCES**

Appellants are unaware of any other appeals or interferences related to this Appeal. The undersigned is Appellants' legal representative in this Appeal.

3. **STATUS OF CLAIMS**

Claims 45-58 are currently pending.

4. **STATUS OF AMENDMENTS**

There are no outstanding amendments to be considered by the Board.

5. **SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention relates generally to the field of medical diagnostic and imaging systems. More particularly, the invention relates to interactive servicing of such systems, such as via remote service facilities, in which system configurations, image data and other files, protocols, service requests, reports and other useful information can be exchanged interactively between a remote service facility and the diagnostic system. In this field, medical diagnostic systems typically included circuitry for acquiring image data and for transforming the data into a useable form, which was then processed to create a reconstructed image of features of interest within the patient. *See*, Application at page 1, lines 6-12.

The Application contains 2 independent claims, namely, claims 45 and 52, both of which are the subject of this Appeal. The subject matter of these claims is summarized below.

With regard to the aspect of the invention set forth in independent claim 45, discussions of the recited features of claim 45 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in accordance with claim 45 provides a method for providing remote service to a medical diagnostic system. The method comprises originating a service request for operational servicing of the medical diagnostic system via a user interface in the medical diagnostic system. *See, id.*, page 22, lines 5-23; *see also* Fig. 8. The method further comprises transmitting (e.g., 268) the service request to a service facility via a network connection. *See, e.g., id.* at page 28, line 6; *see also* Fig. 12. Further, the method comprises acknowledging (e.g., 270) receipt of the service request automatically by the service facility via an electronic message to the medical diagnostic system. *See, id.*, page 24, lines 28-31; page 28, lines 6-10; *see also* Figs. 12.

With regard to the aspect of the invention set forth in independent claim 52, discussions of the recited features of claim 52 can be found at least in the below cited locations of the specification and drawings. By way of example, an embodiment in accordance with claim 52 provides a method for exchanging service data between a plurality of medical diagnostic systems and a central service facility. The method comprises composing (e.g., 208, 258) a service message on a medical diagnostic system, the service message relating to operational servicing of the medical diagnostic system. *See, e.g., id.* at page 22, line 27-page 23, line 6; *see also* Figs. 8 and 12. The method further comprises linking (e.g., 256) the medical diagnostic system to a remote service facility via a network connection. *See, e.g., id.* at page 26, line 31-page 27, line 1; *see also* Fig. 12. Further, the method comprises transmitting (e.g., 268) the service message from the medical diagnostic system to the remote service facility for remote operational servicing of the medical diagnostic system. *See, e.g., id.* at page 28, line 6; *see also* Fig. 12. Further, the

method comprises automatically replying to the service message by the service facility to the medical diagnostic system via a return electronic message. *See, id.* at page 16, line 6.

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

First Ground of Rejection for Review on Appeal:

Appellants respectfully urge the Board to review and reverse the Examiner's sole ground of rejection in which the Examiner rejected claims 45-58 under 35 U.S.C. § 103(a).

Appellants note that claims 45-58 were originally submitted in the parent application as claims 22-35. Appellants further note that independent claims 45 and 52 were originally filed as independent claims 22 and 29 in the parent application. In rejecting claims 22-35, the Examiner formulated the rejection on the basis of 35 U.S.C. §103(a), indicating that the subject matter of these claims is unpatentable over Jago et al. (U.S. Patent No. 5,938,607; hereinafter "Jago") in view of an excerpt from a Microsoft manual entitled "Microsoft Exchange STEP BY STEP" (hereinafter "the Microsoft document").

7. **ARGUMENT**

As discussed in detail below, the Examiner has improperly rejected the pending claims. Further, the Examiner has misapplied long-standing and binding legal precedents and principles in rejecting the claims under Section 103. Accordingly, Appellants respectfully request full and favorable consideration by the Board, as Appellants strongly believe that claims 45-58 are currently in condition for allowance.

The Examiner rejected claims 45-58 under 35 U.S.C. § 103(a) as being unpatentable over Jago in view of the Microsoft document. Because the Examiner rejected each of independent claims 45 and 52 (formerly claims 22 and 29 in above referenced parent application) on the same basis, Appellants will discuss these independent claims together below.

A. Judicial precedent has clearly established a legal standard for a *prima facie* obviousness rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes all of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

B. The Examiner's rejection of independent claims 45-58 is improper because the rejection fails to establish a *prima facie* case of obviousness.

Independent claim 45 recites:

A method for providing remote service to a medical diagnostic system, the method comprising the steps of:
 originating a service request for operational servicing of the medical diagnostic system via a user interface in the medical diagnostic system;
 transmitting the service request to a service facility via a network connection;
 acknowledging receipt of the service request automatically by the service facility via an electronic message to the medical diagnostic system.

Independent claim 52 recites:

A method for exchanging service data between a plurality of medical diagnostic systems and a central service facility, the method comprising the steps of:
composing a service message on a medical diagnostic system, the service message relating to operational servicing of the medical diagnostic system;
linking the medical diagnostic system to a remote service facility via a network connection;
transmitting the service message from the medical diagnostic system to the remote service facility for remote operational servicing of the medical diagnostic system; and
automatically replying to the service message by the service facility to the medical diagnostic system via a return electronic message.

The Teachings Of Jago And The Microsoft Document Do Not Teach Automatic Acknowledgment Or Reply To A Request

In the Office Action following the decision of the Board of Patent Appeals and Interferences regarding the parent application (serial number 09/199,506), in which the originally filed independent claims 22 and 29 were the subject to an appeal and are the subject of this appeal as independent claims 45 and 52, the Examiner characterized the discussion of the Board of Patent Appeals and Interferences, in their decision of January 18, 2005, as concluding that Jago teaches all elements of claims 45 and 52 except the automatic acknowledgment of a submitted service request. It is Appellants' understanding that, in fact, the Board concluded that the combination of Jago and a secondary reference did not teach automatic acknowledgment or reply to such a service request. Overlooking the fact that the Examiner no longer relied upon the same secondary reference, and now relies upon Jago in combination with the Microsoft document, Appellants still submit that: (1) the Microsoft document does not provide for automatic acknowledgement of service requests as claimed; and (2) the Examiner has advanced no reasonable basis for combination of these references.

First, the Microsoft document does set forth a well understood mechanism for informing users that an e-mail recipient is absent. The very page relied upon by the

Examiner, however, clearly indicates that all e-mails to the out-of-office recipient *will not be answered*. Indeed, many such messages could clearly go unanswered. The document states:

[b]efore you leave your office upon extended period of time, the first thing you'll probably want to do is create an AutoReply, which is a feature of the Out-Of-Office Assistant. An AutoReply is a text message that is sent to each person who sends you mail. *The Out-Of-Office Assistant sends only one response to each person that has sent you mail -- regardless of the number of times the person sends you messages.* This avoids sending each person duplicate AutoReply messages. When you return to the office and log on to Microsoft Exchange to resume replying to your own messages, you are reminded that the Out-of-Office Assistant is activated so that you don't forget to turn it off.

The Microsoft document, page 94 (emphasis added).

Thus, even if combined, the references do not teach replying automatically to service requests as recited in claims 45 and 52. According to the Microsoft document itself, second, third, and any further messages from any particular sender simply will not be answered.

Furthermore, the Examiner has provided no reasonable basis for combining these references. The Examiner, on the contrary, appears to have suggested an improvement to the Jago system based entirely upon either the present application or pure speculation on the part of the Examiner. The Examiner's actual reasoning is summarized as follows:

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's [sic] invention was made to incorporate the auto-reply feature and/or the idea of the same to enhance Jago's e-mail capability, with the motivation, to enable responding without human intervention with Jago's system. Because the elimination of human intervention would obviously saving cost [sic]

while assuring clients' [sic] that the request has reached the designated destination, such as service center, or the like.

Office Action mailed 08/08/2005, page 3.

Jago clearly provides no teaching whatsoever for automatic reply to a service request. One skilled in the art could only conclude either that the Jago system was incapable of providing such automatic response, or that for some reason Jago preferred not to provide such responses. If it is assumed that Jago intended to make a useable, cost-effective and commercially successful product, the very motivation submitted by the Examiner would have motivated Jago to include such automatic replies. Because Jago did not, one skilled in the art can only conclude from the reference that the absence of such "well known technology" could only have been a matter of conscious choice. That is, the motivation suggested by the Examiner is not reasonable, and Jago himself did not find it to be so.

The absence of an automatic acknowledgment feature in a service request handling approach, such as that recited in claims 45 and 52, would not necessarily have motivated a person skilled in the art to modify the Jago system to include such automatic response capabilities. Indeed, the Jago system might operate quite effectively without automatic responses to service requests. The service requests could be responded to quickly and effectively by human intervention, or perhaps Jago simply preferred to have a human operator reply to service requests. Certainly, nothing in the references in any way suggests the modification proposed by the Examiner. Appellants submit that the purported motivation advanced by the Examiner is based upon pure conjecture by the Examiner, and not reasonable evidence.

In conclusion, because the references, even if combined, do not enable the invention recited in claims 45 and 52, and because there is no reasonable motivation for combining the references as proposed, claims 45 and 52, and claims depending

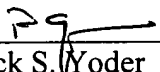
therefrom, are believed to be clearly allowable over the cited prior art. Reversal of the outstanding rejections is therefore requested.

Conclusion

Appellants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner or Board wishes to resolve any other issues by way of a telephone conference, the Examiner or Board is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: July 31, 2006



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8. **APPENDIX OF CLAIMS ON APPEAL**

Listing of Claims:

1.-44. (canceled).

45. (new) A method for providing remote service to a medical diagnostic system, the method comprising the steps of:

originating a service request for operational servicing of the medical diagnostic system via a user interface in the medical diagnostic system;
transmitting the service request to a service facility via a network connection;
acknowledging receipt of the service request automatically by the service facility via an electronic message to the medical diagnostic system.

46. (new) The method of claim 22, comprising the further step of transmitting operational data from the medical diagnostic system to the service facility representative of a potential operational malfunction of the medical diagnostic system.

47. (new) The method of claim 23, wherein the operational data is transmitted from the medical diagnostic system to the service facility in response to a prompt by the service facility.

48. (new) The method of claim 24, wherein the prompt is generated by the service facility automatically in response to the service request.

49. (new) The method of claim 22, comprising the further step of transmitting from the medical diagnostic system data representative of the medical diagnostic system type and identification.

50. (new) The method of claim 22, wherein the service request is generated through a preconfigured browser page accessible on the user interface.

51. (new) The method of claim 22, comprising the further step of displaying a visual indicia at the medical diagnostic system indicating receipt of the electronic message from the service facility.

52. (new) A method for exchanging service data between a plurality of medical diagnostic systems and a central service facility, the method comprising the steps of:

composing a service message on a medical diagnostic system, the service message relating to operational servicing of the medical diagnostic system;

linking the medical diagnostic system to a remote service facility via a network connection;

transmitting the service message from the medical diagnostic system to the remote service facility for remote operational servicing of the medical diagnostic system; and

automatically replying to the service message by the service facility to the medical diagnostic system via a return electronic message.

53. (new) The method of claim 29, wherein the service message is composed via a user interface.

54. (new) The method of claim 29, wherein the service message includes data uniquely identifying the medical diagnostic system.

55. (new) The method of claim 31, comprising the further step of automatically accessing electronic records relating to the medical diagnostic system by the service facility in response to the service message.

56. (new) The method of claim 32, wherein the electronic records include data representative of an operational service subscriber status of the medical diagnostic system.

57. (new) The method of claim 32, wherein the electronic records include data representative of operational service history for the medical diagnostic system.

58. (new) The method of claim 29, comprising the further steps of:
determining at the service facility log data required to reply to the service message;
automatically linking the service facility to the medical diagnostic system via a
network connection; and
transmitting the log data from the medical diagnostic system to the service facility.

9. **APPENDIX OF EVIDENCE**

None.

10. **APPENDIX OF RELATED PROCEEDINGS**

None.